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## STANDING COMMITTEE ON THE LAW OF TRADE MARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

### Second Special Session on the Report of the Second WIPO Internet Domain Name Process

Geneva, May 21 to 24, 2002

THE PROTECTION OF THE NAMES AND ACRONYMS OF INTERNATIONAL  
ORGANIZATIONS IN THE DOMAIN NAME SYSTEM

*Document prepared by the Secretariat*

1. The Report of the first Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (document SCT/S1/6) concluded that "[t]he majority of delegations expressed interest in accord[ing] some protection to the names and acronyms of IGOs against abusive registration as domain names, but considered that further work was needed to identify the way in which any such protection might function. The Special Session asked the Secretariat to consult with other IGOs to provide evidence of the extent of problems encountered with the abusive registration of names and acronyms of IGOs as domain names. Such evidence should be presented to the second Special Session. In addition, the Special Session asked the Secretariat to provide a paper giving details of how any proposed protection of names and acronyms of IGOs would function in practice."

2. The present document provides further evidence of the extent of problems encountered with the abusive registration of names and acronyms of international organizations as domain names and proposes, for consideration by the SCT, options for a mechanism aimed at combating such problems.

## SUBMISSIONS BY INTERNATIONAL ORGANIZATIONS

3. Since the first Special Session, the Secretariat has been liaising, in particular, with the Legal Advisers of the United Nations System, the International Federation of Red Cross and Red Crescent Societies, the International Committee of the Red Cross and the Organisation for Economic Cooperation and Development with a view to the collection of further evidence of the abusive registration of the names and acronyms of international organizations as domain names and the resulting harm for users and the organizations affected. The Legal Advisers of the United Nations held their annual meeting in Geneva on March 7 and 8, 2002 and were briefed by the Legal Counsel of WIPO on the discussions regarding the protection of the names and acronyms of IGOs in the Domain Name System (DNS) held at the first Special Session of the SCT. The International Federation of Red Cross and Red Crescent Societies, the International Committee of the Red Cross and the Organisation for Economic Cooperation and Development were similarly briefed by the Secretariat. As a result of these initiatives, the Secretariat received three papers from the organizations in question concerning their experience with abusive domain name registrations. These papers are briefly summarized in the next paragraphs of this document and are submitted to the SCT for its consideration.

4. The first paper (document SCT/S2/INF/4) by Mr. Hans Corell, Under-Secretary-General for Legal Affairs and Legal Counsel of the United Nations is submitted on behalf of the Legal Advisers of the following Organizations and Programmes of the United Nations System: the United Nations Organization, the Food and Agricultural Organization of the United Nations, the International Bank for Reconstruction and Development/International Development Association, the International Civil Aviation Organization, the International Finance Corporation, the International Fund for Agricultural Development, the International Labour Organisation, the International Maritime Organization, the International Monetary Fund, the International Telecommunications Union, the United Nations Educational, Scientific and Cultural Organization, the United Nations Industrial Development Organization, the Universal Postal Union, the World Health Organization, the World Intellectual Property Organization, the World Meteorological Organization, the International Atomic Energy Agency, the World Trade Organization, the Organization for the Prohibition of Chemical Weapons, the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization, the Bank for International Settlements, the International Organization for Migration, and the Secretariat of the Convention for Climate Change.

5. In their paper, the Legal Advisers of the United Nations System observe that “the registration of the names and acronyms of international intergovernmental organisations as domain names by unauthorised parties, including registration and use for misleading, deceptive or dishonest purposes, continues unabated.” Further examples of such registrations are set out in an annex to the paper. The Legal Advisers note that the Uniform Domain Name Dispute Resolution Policy (UDRP) offers an “effective, rapid and simple means” for owners of trade and service marks to combat cybersquatting and submit that it be “modified to cover abusive registrations of the names and acronyms of international intergovernmental organizations in a manner that would respect the immunity of such organizations and would not require an intergovernmental organisation which is a party to a UDRP proceeding to submit to the jurisdiction of national courts...” As an alternative to such submission to national courts and with a view to ensuring that a domain name registrant against whom a UDRP decision is rendered has the opportunity to have his or her case re-considered, the Legal Advisers propose “the establishment of a special panel of appeal within the UDRP for the purposes of reviewing the decisions rendered...”

6. Thesecondpaper(SCT/S2/INF/3)isajointsubmissionbytheInternationalFederationofRedCrossandRedCrescentSocietiesandtheInternationalCommitteeoftheRedCrossontheir experiencewithabusivedomainnameregistrations.Thepaperlistsanddescribesanumberof examplesofabusiveregistrationsofwhichtheRedCrossMovementwasthevictimandrequests StatetocomplywiththeirobligationsundertheGenevaConventionsbyarrangingforthe extensionoftheUDRPtoalldesignationsprotectedbyinternationallaw.Thepaperalsoexplains theprotectionofferedunde rinternationallawtotheemblemsanddesignationsoftheRedCross MovementundertheGenevaConventionsof12August1949.<sup>1</sup>

7. Thethirdpaper(SCT/S2/INF/2)wassubmittedbytheOrganisationforEconomic CooperationandDevelopment(OECD). ThispaperdetailstheOrganization'sdifficultiesintrying torecuperateadomainnameregisteredinthe.ORGTLDCorrespondingtotheFrenchacronymof theOrganizationandconcludes,basedonthatexperience,that“somethingisquitewronginthe currentsystemandthepublicinterestisnotbeingwellprotectedbyit.”

## LEGALBASISFORPROTECTION

8. Theprincipallegalbasisforthe protectionofthenamesandacronymsofIGOs in internationallawisArticle6 *ter*oftheParisConventionfor theProtectionofIndustrialProperty (theParisConvention).AnexhaustiveanalysisofthisArticle ,aswellascorrespondingprovisions oftheTrademarkLawTreatyandtheAgreementonTrade -RelatedAspects ofIntellectual PropertyRights(TRIPSAgreement),andtheirimplicationsforthe protectionofthenamesand acronymsofIGOs intheDNSiscontainedintheReportoftheSecondWIPOInternetDomain NameProcess.<sup>2</sup>

9. Anumberofdesignations,whilenotfallingundertheambitofArticle6 *ter*oftheParis Convention,arenonethelessalsoprotectedbyinternationallaw,onthebasisofothertreaty provisions.Notably,thisisthecasefortheemblemsanddesignationsoftheRedCross Movement.SuchpossibilityisexplicitlyrecognizedbyArticle6 *ter*oftheParisConvention, whichstates,initsparagraph(1)(b),thattheprotectionwhichitoffersdoesnotapplyto“armorial bearings,flags,otheremblems,abbreviations,andnames,thatarealreadythesubjectof internationalagreementsinforce,intendedtoensuretheirprotection.”Accordingtowell -known commentators,thisexception“isprobablyintendedtoavoiddouble,andpossiblyconflicting, protectionincaseswheretheemblemsandnameofanorganizationarealreadyprotectedby a Convention,suchastheGenevaConventionfortheameliorationoftheconditionofthewounded andsickinarmedforces,ofAugust12,1949.”<sup>3</sup>

10. Thelevelandscopeofprotectionofferedtoanygivendesignationhastobeassessedinlight ofthespecificprovisions oftheapplicable treaty.Forinstance,inthecaseoftheParisConvention

<sup>1</sup> ThefirstparagraphofArticle53oftheFirstGenevaConvention,towhich189Statesareparty, stipulatesasfollows:“The usebyindividuals,societies,firmsorcompanieseitherpublicorprivate, otherthanthoseentitledtheretounderthepresentConvention,oftheemblemorthedesignation‘Red Cross’or‘GenevaCross,’orany signordesignationconstitutinganimitation thereof,whateverthe objectofsuchuse,andirrespectiveofthedateofitsadoption,shallbeprohibitedatalltimes.”

<sup>2</sup> Seeparagraphs128through138oftheReportoftheSecondWIPOInternetDomainNameProcess.

<sup>3</sup> SeeG.H.C.Bodenhausen,Guideto theApplicationoftheParisConventionfortheProtectionof IndustrialProperty,p.97 -98.

and the Trademark Law Treaty, the protection is confined to placing restrictions on the possibility of registering or using the names and acronyms of certain IGOs as trade or service marks, whereas the protection under the Geneva Convention is broader and prohibits, subject to certain exceptions, the use by anyone, other than those entitled under the Convention, of the Red Cross emblem or designation “whatever the object of such use.”

11. *The SCT is invited to decide whether it would be appropriate to establish mechanisms for the protection of the names and acronyms of international organizations in the DNS. If the SCT were to decide this to be appropriate, the SCT also is invited to decide:*

(i) *whether such protection should extend only to those names and acronyms of international organizations that benefit from protection under Article 6ter of the Paris Convention; or*

(ii) *whether such protection should extend to the names and acronyms of international organizations that benefit from protection under Article 6ter of the Paris Convention and to those other names and acronyms that are the subject of specific protection under identified treaties.*

## POSSIBLE PROTECTION MECHANISMS

12. A number of elements have emerged from the discussions on the protection of the names and acronyms of international organizations that need to be taken into account when considering the form which such protection might appropriately take, assuming its establishment were to be desired in principle. These elements are as follows:

(i) Most abusive domain name registrations affecting international organizations are misleading variations of their names and acronyms, rather than being identical thereto.

(ii) The number of abusive registrations of acronyms of international organizations is significantly higher than those affecting their full names.

(iii) In many cases it would appear that domain name registrants may have a legitimate interest in the acronym of an international organization.<sup>4</sup>

(iv) From an overall efficiency perspective, it would be preferable to rely on existing legal frameworks for the protection of names and acronyms of international organizations in the DNS, rather than creating new special-purpose forms of protection.

<sup>4</sup> See the discussion in paragraph 153 of the Second WIPO Process Report concerning the acronym “WHO.”

(v) Registrants who would lose their registrations as a result of the application of any protective measures, for reasons of due process, should have the opportunity to have their cases reconsidered.

(vi) Any protective measures should recognize the privileges and immunities from which the United Nations and its Specialized Agencies benefit under international law.

13. It would appear that an administrative challenge procedure is best able to meet the sometimes competing objectives mentioned in the previous paragraph. Such procedure would have many of the same features as the one proposed by the Secretariat for the protection of country names in paragraphs 28 through 38 of document SCT/S2/3, namely:

(i) It would be adversarial in nature and neutral decision maker(s) would rule upon the disputes.

(ii) It would offer protection to domain names that are identical or misleadingly similar to the names and acronyms of international organizations that benefit from protection under Article 6 *ter* of the Paris Convention or international law generally.

(iii) The procedure would be administrative in nature and the decision emanating from it would not, as such, have weight of binding precedent under national judicial systems.

(iv) The procedure, as such, would not prevent the parties from bringing the case before a court of competent jurisdiction either before, during or after the proceedings. Nonetheless, questions of immunities may arise before national courts which could prevent registrants from having their cases effectively reconsidered. Because registrants, for due process reasons, should have the ability to challenge decision emanating from the procedure, it is proposed that the procedure incorporate an appeal by way of arbitration, as proposed by the Legal Advisers of the United Nations System in their paper.

(v) Decision emanating from the procedure would be enforced directly by the domain name registration authorities that have adopted the procedure (including ICANN and its accredited registrars).

(vi) The procedure would be limited to instances of bad faith, which would be defined as the registration and/or use of a domain name which is identical or misleadingly similar to the name or acronym of an international organization benefiting from protection under Article 6 *ter* of the Paris Convention or international law generally, without any right or legitimate interest on the part of the registrant in the name and where users are likely to be misled into believing that there is an association between the registrant and the international organization in question.

(vii) The procedure should apply to all existing and future gTLDs, the question of acquired rights being resolved by restricting the scope of the procedure to instances of bad faith. The procedure also would apply to those ccTLDs whose administrators have voluntarily decided to adopt it for their domains.

14. A choice would have to be made whether to implement the protection through an amendment of the UDRP or through a special administrative procedure that is distinct from, but akin to, the UDRP. The advantages and disadvantages of both approaches in relation to the names

and acronyms of international organizations are essentially the same as those in relation to country names, and are discussed in paragraphs 39 through 43 of document SCT/S2/3.

15. *The SCT is invited to decide whether it would be appropriate to protect the names and acronyms of international organizations through an administrative dispute resolution procedure. If the SCT were to decide this to be appropriate, the SCT also is invited to decide:*

*(i) whether such procedures should have the characteristics proposed in paragraph 13;*

*(ii) whether such procedures should be effectuated through broadening of the scope of the UDRP or through the creation of a new mechanism into the UDRP; and*

*(iii) whether there -consideration of any cases brought under the procedures should be achieved through an appeal mechanism, by way of arbitration, incorporated into the administrative procedure.*

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